



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF
PATENTS AND TRADEMARKS
Washington, D.C. 20231

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 57

Application Number: 08/427,468

Filing Date: 4/24/95

Appellant(s): Friese et al

Joel A. Rothfus
For Appellant

AC
~~MAILED~~
OCT 14 1998
~~Group 3700~~

EXAMINER'S ANSWER

MAILED
DEC 14 1998
Group 3700

This is in response to appellant's brief on appeal filed August 10, 1998.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Art Unit: 3735

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 9-12, 14-19 and 23-26.

Claims 1-8, 13, 20-22 and 27-28 have been canceled.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on August 10, 1998 has been entered.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because The Examiner agrees with the Summary except for that on page 3, lines 9-14, which, as discussed infra, pertain to subject matter which is at issue.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: On August 31, 1998, Appellants submitted a supplemental appeal brief because of an alleged "Examiner's newly stated position" in the Advisory Action. However,

Art Unit: 3735

the Examiner did not state a new position but relied on the positions set forth in the FINAL, i.e. new matter and lack of enablement. Thus, no new issue was raised. The arguments submitted will be addressed when arguments with respect to A and B are addressed.

(7) *Grouping of Claims*

Issue A:

Appellant's brief includes a statement that claims 9-12 and 14-19, do not stand or fall

as a group, and claims 23-26, 98, 910/1

together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

Issue B:

Appellant's brief includes a statement that claims 9-12 and 14-19, as group, and claims 23-26, as a group, do not stand or fall together and provides reasons as set forth in 37 CAR 1.192(c)(7) and (c)(8).

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Issue A:

Art Unit: 3735

The objection on page 2, lines 6-9, i.e. 'The.. 20-21", line 11 and the rejection bridging pages 2-3, except for its application to claim 28, in the FINAL rejection, Paper No 48, is repeated here.

Issue B:

The rejection on page 3, first full paragraph of the FINAL rejection, Paper No 48, is repeated here.

(11) Response to Argument

Issue A:

Appellant's remarks at page 5, lines 11-29 of the Brief and page 2, lines 7-10
^{Brief}
and 12-16 of the ^ASupplemental have been noted.

Appellants remarks on page 5, second to last line-page 6, line 3 and 5-7 of the Brief and page 2, lines 10-11 and 18-24 and page 2, line 25-page 3, line 1 of the Supplemental Brief have been considered but are deemed non-persuasive in view of page 3, lines 13-17 and 20-21 as originally filed and Figures as originally filed and page 2, lines 12-14 of the FINAL rejection, Paper No 48, and page 3, first and last paragraphs of Paper No. 42.

Appellant's remarks on page 6, lines 3-5 of the Brief have been noted. See page 3, lines 1-3 of the FINAL rejection, Paper No 48.

The rejection of the claims under 35 U.S.C. 112, first paragraph, is deemed proper and maintained.

Issue B:

Art Unit: 3735

The Appellant's arguments on page 7, lines 15-19 are noted but deemed moot in view of the Advisory Action.

Appellant's arguments on page 6, lines 11 et seq, and page 7, lines 1-9 of the Brief and page 2, lines 16-17 and 24 of the Supplemental Brief are noted. See not only discussion of Issue A supra but also the paragraph bridging pages 3-4 of the FINAL rejection, Paper No 48, i.e. at most the entire invention is not enabled, at the very ^elast all embodiments thereof are not enabled.

Appellant's remarks on page 7, line 9-14 have been noted but are deemed nonpersuasive for the same reasons as set forth with regard to similar arguments in Issue A.

The rejection of the claims is deemed proper and maintained.

Art Unit: 3735

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


K. Reichle:bhw
(703) 308-2617
December 4, 1998


John G. Weiss
Supervisory Patent Examiner
Group 3700

Audley A. Ciamporcero Jr.
Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, N.J. 08933-7003